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Technology Center 2100

In re Application of: John S. Yates Jr., et al.)
Application No.: 09/626,325)
Filed: July 26, 2000)
For: OPERATING SYSTEM FOR)
COMPUTER WITH TWO)
ARCHITECTURES)

**DECISION ON PETITION
UNDER 37 CFR §1.181 FOR
SUPERVISORY REVIEW**

This is a decision on the petition under 37 CFR 1.181 filed December 14, 2005 invoking the Director's supervisory review. Petitioner requests (a) withdrawal of the finality of the Office action mailed on July 19, 2005 and (b) that the Director review the objection to the specification as containing new matter.

The petition is **GRANTED-IN-PART**.

RECENT RELEVANT PROSECUTION BACKGROUND

- May 2, 2005 - RCE filed including amendments to the specification and claims.
- July 19, 2005 - Examiner mails an Office action designated as a Final Office action in which claims 31-33, 35, and 37-43 are rejected; claims 34 and 36 are objected to; and the amendment to the specification is objected to as introducing new matter into the disclosure.
- September 15, 2005 - Applicant files a paper denominated as a Petition for Review which raises the issues of whether the finality of the Office action was premature and whether the objection to the specification was proper. This paper was referred to the examiner of record to be treated as a request for reconsideration.
- October 14, 2005 - An Advisory action is mailed maintaining the Finality of the July 19 Office action and the objection to the May 2, 2005 amendment to the specification as introducing new matter.

December 14, 2005 - Applicant files the instant petition for review.

BASIS OF OPINION

The relevant sections of the Statutes, Rules and MPEP are reproduced below with emphasis added :

37 CFR §1.104. Nature of examination.

...

(b) Completeness of examiner's action . The examiner's action will be ***complete as to all matters***, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

MPEP §2143.03 All Claim Limitations Must Be Taught or Suggested

...

LIMITATIONS WHICH DO NOT FIND SUPPORT IN THE ORIGINAL SPECIFICATION MUST BE CONSIDERED

When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter). Ex parte Grasselli, 231USPQ 393 (Bd. App. 1983) aff'd mem. 738 F.2d 453 (Fed. Cir. 1984)

MPEP §2163.06 Relationship of Written Description Requirement to New Matter

...

I. TREATMENT OF NEW MATTER

If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate, and require applicant to cancel the new matter. If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). ***The examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant.***

In an instance in which the claims have not been amended, per se, but the specification has been amended to add new matter, ***a rejection of the claims under 35 U.S.C. 112, first paragraph should be made whenever any of the claim limitations are affected by the added material.***

When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not “new matter” is involved. ***Applicant should therefore specifically point out the support for any amendments made to the disclosure.***

MPEP §608.04(c) Review of Examiner’s Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancelation is by way of petition. ***But where the alleged new matter is introduced into or affects the claims***, thus necessitating their rejection on this ground, ***the question becomes an appealable one, and should not be considered on petition*** even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 37 CFR 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

OPINION

I. Finality of the July 19, 2005 Office action

A review of the record reveals that the May 2, 2005 amendment included significant changes to the language of independent claims 31 and 38. In paragraphs number 4-6 of the July 19 Office action the examiner rejects these claims as clearly anticipated by Hammond and relies on the rejections as set out in the October 27, 2004 Office action.

The Office action makes no mention of the new claim language. The incorporation of the previous rejection without any comment on the scope of the amended claim indicates that the amendatory language was not considered. Therefore, the action is “not complete as to all matters”.

Furthermore, the Examiner states (paragraph 8.1):

Since that definition therefore forms no part of the original specification, the claims cannot be narrowed by that definition in the specification to result in them potentially overcoming the cited prior art.

However, as directed in MPEP §2163.03, the Examiner is required to examine the application as amended. Specifically, “a rejection of the claims under 35 U.S.C. 112, first paragraph should be made whenever any of the claim limitations are affected by the added material”.

Accordingly, the action mailed July 19, 2005 is incomplete and is hereby **VACATED**.

II. Propriety of the New Matter Objection

At this juncture a petition to review the new matter objection is premature. Since the Examiner did not issue a complete action it is not clear whether the Examiner is of the opinion that the "alleged new matter affects the claims". Accordingly, the request for review is **DISMISSED**.

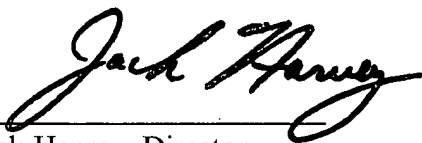
Should the Examiner issue a new Office action which objects to the amendment to the specification as introducing new matter and also holds that the amendment does not affect the claims and therefore does not enter a rejection of any claim under 35 U.S.C. §112 based on new matter, at that point the issue will be ready for review.

CONCLUSION

The Petition is **GRANTED** to the extent that the July 19, 2005 action is **VACATED**.

The application is being forwarded to the Examiner to issue a new complete Office action treating all claims pending in the application. The action should make clear whether any claims are rejected under 35 U.S.C. § 112 and provide reasons therefor.

Any inquiries with respect to this decision may be addressed to Special Programs Examiner Pinchus M. Laufer at (571) 272-3599.



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